



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,768	07/31/2001	Jeffry J. Grainger	021737-000530US	4992

20350 7590 06/02/2009  
TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER
----------

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
----------	--------------

3689

MAIL DATE	DELIVERY MODE
-----------	---------------

06/02/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* JEFFRY J. GRAINGER, JAMES R. SHAY,  
and CECILY ANNE SNYDER

---

Appeal 2008-005163  
Application 09/919,768  
Technology Center 3600

---

Decided:<sup>1</sup> June 2, 2009

---

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU  
R. MOHANTY, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

---

<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-12, 14-19 and 21-22<sup>2</sup>. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6.

The claimed invention is directed to systems and methods for automatically generating information disclosure statements associated with obtaining and maintaining intellectual property rights such as patent rights (Spec. p. 1, ll. 24-27).

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A computer implemented method of processing documents received on a server system comprising:
  - storing a plurality of references on the server system, wherein the plurality of references are electronic documents, the plurality of references comprising a first reference comprising a set of reference information to be disclosed to a patent office;
  - receiving a citation document on the server system, wherein the citation document is an electronic document including citation information for one or more prior art reference documents;
  - providing communication between the server system and a client system, wherein the client system is configured to provide interaction between a user and the server system;
  - displaying the citation information in the citation document to a user of a client system, in a first display section; and

---

<sup>2</sup> Unlike the reference to independent claims 21 and 22 on pages 3-4 of the Examiner's Answer, dependent claim 20 has not been addressed as having been rejected over the prior art.

displaying, in a second display section, an identifier corresponding to the first reference; and providing an interface element associated with the identifier, wherein the interface element is configured to receive, from the user, input pertaining to the first reference, the input comprising information about a relationship between at least some of the citation information in the citation document and the first reference.

The references of record relied upon by the Examiner as evidence of obviousness are:

Porcari	US 2001/0037460 A1	Nov. 1, 2001
Rivette et al.	US 2003/0046307 A1	Mar. 6, 2003

Claims 1-12, 14, 16-19 and 21-22 stand rejected under 35 U.S.C. § 102(e) as anticipated by Porcari; claim 12 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Porcari; and claim 15 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Porcari in view of Rivette.

We AFFIRM.

### ISSUES

Did the Appellants show the Examiner erred in finding that Pocari discloses a server system that stores both a plurality of references and a citation document as recited in independent claims 1, 21 and 22, where the citation document is an electronic document including citation information for one or more prior art reference documents that is received by the server system?

Did the Appellants show the Examiner erred in finding that Pocari discloses displaying the citation information in the citation document to a user of a client system as recited in independent claims 1, 21 and 22?

Did the Appellants show the Examiner erred in finding that Pocari discloses displaying the citation information in the citation document to a user of a client system, in a first display section and displaying, in a second display section, an identifier corresponding to the first reference as recited in independent claims 1, 21, and 22?

Did the Appellants show the Examiner erred in finding that the mouse and keyboard of Pocari correspond to an interface element as recited in independent claims 1, 21 and 22, where the specification discloses that interface elements include graphical user interfaces, such as radio button, check boxes, and the like?

## FINDINGS OF FACT

### *Specification*

The claimed invention is directed to systems and methods for automatically generating information disclosure statements associated with obtaining and maintaining intellectual property rights, such as patent rights (Spec. p. 1, ll. 24-27).

### *Pocari*

Pocari discloses an on-line invention disclosure system 10 that includes web server 12, user computer 14, directory server 16 and database system 18. Database system 18 may contain both docketing information and disclosure information ([0025]).

While entering the on-line invention disclosure on system 10, other documents may be attached to the disclosure as file attachments, for example, word processing documents, CAD files, prints, flow charts, presentation documents or various other types of documents. These documents are stored on system 10 with the disclosure ([0033], [0039]).

The system may include an on-line invention disclosure and a prior art search function that searches portions of the invention disclosure, various on-line search engines and various search vendors. The results of the search are presented to the inventor at step 204 and stored together with the disclosure ([0045]).

As the USPTO requires disclosure of relevant references, system 10 may also include a system to reference prior art documents and a method to hyperlink to the stored references. The system may include an Information Disclosure Statement including hyperlinks to documents identified in the Information Disclosure Statement ([0056]).

The docketing system records the prior art reference through either a citation system such as patent number (country, number, kind) or through a uniform citation system as are commonly used in technical journals. The docketing system prepares an information disclosure statement where the citation system links to a repository on the internet that contains the referenced document ([0058]).

System 10 inherently includes a keyboard such that the user can enter their user ID at step 102 and fill in invention data at step 106 via user computer 14.

## PRINCIPLES OF LAW

### *Claim Construction*

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

While the specification can be examined for proper context of a claim term, limitations from the specification will not be imported into the claims. *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir. 2005).

A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Inter. 1987).

## ANALYSIS

### *Server System*

We are not persuaded of error on the part of the Examiner by Appellants’ argument that Pocari does not disclose a server system that stores both a plurality of references and a citation document as recited in independent claims 1, 21 and 22, where the citation document is an electronic document including citation information for one or more prior art reference documents that is received by the server system (App. Br. 16).

Regarding the plurality of references, claims 1, 21 and 22 recite that the plurality of references are electronic documents, the plurality of references comprising a first reference comprising a set of reference information to be disclosed to a patent office. The Appellants assert that the “plurality of references” are limited to *prior art patent documents*. However, no such limitation is set forth in the claims. *See CollegeNet, Inc.*, 418 F.3d at 1231.

Pocari discloses that system 10 stores on-line disclosure documents with file attachments. The prior art search function searches on-line search engines, as well as the invention disclosure and attachments for relevant prior art documents. Since the prior art search function searches the invention disclosure and attachments, it follows that the invention disclosure and attachments are being searched because they contain relevant prior art documents and information. As Pocari discloses that relevant references must be disclosed to the USPTO, the invention disclosure and attachments of Pocari are a plurality of references as recited in the claims.

Pocari also discloses that system 10 receives and stores prior art search results, for example, from on-line search engines. These results are the recited citation document, as the prior art search results include citation information for one or more prior art reference documents as recited in the claims.

Accordingly, system 10 of Pocari stores both a plurality of references and a received citation document as recited in independent claims 1, 21 and 22.



*Citation Information*

We are not persuaded of error on the part of the Examiner by Appellants' argument that Pocari does not disclose displaying the citation information in the citation document to a user of a client system as recited in independent claims 1, 21 and 22 (App. Br. 16-17). As set forth above, the prior art search results comprise a citation document. The prior art search results include citation information for references found in the disclosure, various on-line search engines and various search vendors. The prior art search results are presented to the inventor in step 204 at user computer 14.

*First and Second Display Sections*

We are not persuaded of error on the part of the Examiner by Appellants' argument that Pocari discloses displaying the citation information in the citation document to a user of a client system, in a first display section and displaying, in a second display section, an identifier corresponding to the first reference as recited in independent claims 1, 21, and 22 (App. Br. 17-18). The Appellants assert that the first and second display sections of the claims 1, 21 and 22 are *non-overlapping, mutually-exclusive* display sections set forth on the *same screen*. However, no such limitation is set forth in the claims. *See CollegeNet, Inc.*, 418 F.3d at 1231.

As set forth above, the prior art search results are a citation document that is presented to the inventor in a first display section in step 204. The prior art search results include citation information for multiple prior art references, any one of which is an identifier corresponding to the first reference as recited in independent claims 1, 21, and 22. Accordingly, the portion of the prior art search results that includes just the identifier is a

smaller, overlapping display section that is nevertheless a second display section under a broadest reasonable interpretation. *See In re American Academy of Science Tech Center*, 367 F.3d at 1364.

*Interface Element*

We are not persuaded of error on the part of the Examiner by Appellants' argument that the mouse and keyboard of Pocari do not correspond to an interface element as recited in independent claims 1, 21 and 22, where the specification discloses that interface elements include graphical user interfaces, such as radio button, check boxes, and the like (App. Br. 18-19). The Appellants assert that the recited interface element is a *graphical* interface element. However, no such limitation is set forth in the claims. *See CollegeNet, Inc.*, 418 F.3d at 1231.

All independent claims 1, 21 and 22 recite is that the interface element is *configured to receive, from the user, input* pertaining to the first reference, the input comprising information about a relationship between at least some of the citation information in the citation document and the first reference. By using the word “configured,” all the reference requires is a corresponding structure *capable* of performing the recited action, regardless of whether the corresponding structure is disclosed as *actually* performing the recited action. *See Ex parte Masham*, 2 USPQ2d at 1648<sup>3</sup>. As the keyboard in Pocari has been “provided” and is *capable of receiving all types of*

---

<sup>3</sup> While *Ex parte Masham* is normally applied to apparatus claims, because independent claims 1, 21 and 22 merely recite *providing* the interface element, it is also relevant here.

*informational input*, including the information set forth in the claim, the claim recitation for interface element is met.

*Other Claims*

We sustain the rejection of independent claim 1 for the reasons set forth above. As claims 2-12 and 14-19 depend from independent claim 1 and are not argued separately, we also sustain the rejections of those claims.

CONCLUSION

The Appellants have failed to show that the Examiner erred in rejecting claims 1-12, 14-19, and 21-22.

AFFIRMED

JRG

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834